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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,596	10/30/2001	James P. Baltz	3030-67663	6528

7590 04/13/2004

BARNES & THORNBURG  
11 South Meridian Street  
Indianapolis, IN 46204

EXAMINER
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HWU, DAVIS D

ART UNIT	PAPER NUMBER
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3752

DATE MAILED: 04/13/2004

*9*

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/016,596

Applicant(s)

BALTZ ET AL.

Examiner

Davis Hwu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 9, 10, 13, 16, 17 and 19 is/are rejected.
- 7) ☒ Claim(s) 2, 3, 6-8, 11, 12, 14, 15 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Applicant's appeal brief of February 27, 2004 is acknowledged. In light of the appeal brief and new references, the case is being reopened for prosecution.
2. The final rejection of October 21, 2003 is withdrawn.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 4, 5, 9, 10, 13, 16, 17, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith.

The patent to Smith shows a device providing at least one opening (see Figure 1) and a first level 44 to indicate when a component is in a first orientation. Smith does not disclose the device being used for positioning an air cap of a pneumatically aided atomizer, the air cap having horns which are received by the opening. However, the functional limitations of this claim for positioning an air cap as recited are inherent in the prior art since one of ordinary skill in the art would recognize that the device of Smith is fully capable for use in positioning an air cap having horns since the device of Smith can be clamped onto the air horns of the air cap and that the level will indicate when the horns received in the opening are in a first position. Since the functional limitations of the instant claim are inherent in the prior art, the functional limitations of the instant claim does not give the instant claim patentable weight and therefore the Smith patent

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establishes a prima facie case of anticipation (In re Schreiber). Regarding claim 4, Smith also shows an area 22 having a first surface facing out from Figure 1 and a second surface on the other side of the first surface (see Figure 1). Since starting of the directions of the first and second surfaces are arbitrary, one having ordinary skill in the art would recognize that the starting point of the first surface could be at the bottom of the first surface and the starting point of the second surface could be at the top of the second surface, thus making the surfaces extending in opposite directions. The first opening extends through the device from the first surface to the second surface as recited in claim 5. The device of Smith is fully capable of indicating when the horns received in the opening are in a vertical position or a horizontal position as recited in claims 9 and 10.

#### ***Allowable Subject Matter***

5. Claims 2, 3, 6-8, 11, 12, 14, 15, and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Jaccard, Heinsius et al., Esposito et al., Yakkell, and Parker are pertinent to Applicant's invention.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Davis Hwu whose telephone number is 703-305-1663. The examiner can normally be reached on M-F 7:30 AM to 4:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Y. Mar can be reached on (703)308-2087. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0861.

A handwritten signature in black ink, appearing to be 'Davis Hwu', with a stylized, flowing script.

Davis Hwu